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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,287	10/06/2000	Allan E. Brockenbrough	782.1082/DSG	8376

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EXAMINER	
ESCALANTE, OVIDIO	
ART UNIT	**PAPER NUMBER**
2645	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/679,287	BROCKENBROUGH ET AL.	
	Examiner	Art Unit	
	Ovidio Escalante	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41 and 43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41 and 43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. This action is in response to applicant's amendment filed on March 3, 2005. **Claims 1-41 and 43** are now pending in the present application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 26 is rejected under 35 U.S.C. 102(e) as being anticipated by Ball et al. US Patent 6,459,774.

Regarding claim 26, Ball teaches a voice mail message, (abstract; col. 1, line 65-col. 2, line 13), comprising:

a message area (message storage database 902-fig. 9) containing at least a voice message and each of;

an audio stationary header preceding the message area, (table 1 in col. 8; col. 8, lines 18-52; col. 26, lines 34-59,

an audio stationary footer following the message area, (table 1 in col. 8; col. 8, lines 18-52; col. 26, lines 34-59), and

an audio stationary body occurring at least once in said message area in combination with the voice message, (table 1 in col. 8; col. 8, lines 18-52; col. 26, lines 34-59).

4. Claims 27,28 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Gold et al. US Patent Pub. 2002/0032752.

Regarding claim 27, Gold teaches an apparatus (fig. 1c; paragraph 0031) comprising:

a storage device (database) storing a recorded voice message and sound samples, (paragraphs 0036, 0045 and 0066); and

a processor (paragraph 0068), coupled to the storage device, to provide the sound samples to a user and to combine a selected sound sample with the recorded voice message to form a combination message, (fig. 14; paragraph 0045 and paragraph 0066; after the voice greeting the sound sample dedication is played).

Regarding claim 28, Gold, as applied to claim 27, teaches wherein the storage device stores the combination message, (paragraphs 0036, 0045 and 0063).

Regarding claim 39, Gold, teaches a voice mail platform (fig. 1c; paragraph 0036) comprising:

means for providing sound samples for selection by a user, (fig. 7; paragraph 0045); and

means for receiving an indication of a selected sound sample, (paragraph 0045); and

means for combining a selected sound sample with a recorded voice message to form a combination message, (paragraphs 0045, 0063 and 0066; fig. 14).

5. Claim 43 is rejected under 35 U.S.C. 102(e) as being anticipated by Kawashima US Patent 6,549,767.

Regarding claim 43, Kawashima teaches a method of combining sound with a recorded voice message (abstract) comprising:

recording a voice message from a caller, (col. 7, lines 28-45; col. 10, lines 6-21);

prompting the caller to select one of a plurality of sound samples, (col. 21, lines 38-53); combining the voice message with the selected sound sample to form a combination message, the selected sound sample being loop for a duration corresponding to a duration of the voice message, (abstract; col. 4, lines 37-43).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-3,7-25,30-38, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gold US Patent Pub. 2002/0032752 in view of Ball US Patent 6,459,774.

Regarding claim 1, Gold teaches a method of adding sound to a voice mail message, (abstract; paragraphs 0031, 0036 and 0063), comprising:

providing sound samples for selection by a user, (paragraph 0032, 0036 and 0045; user selects a song to be dedication based on the provided samples);

receiving an indication of a selected sound sample, (paragraphs 0036 and 0045); and

combining the selected sound sample with a recorded voice message to form a combination message, (paragraphs 0045, 0063 and 0066).

While Gold teaches of adding the selected sound sample to form a combination message, Gold does not specifically teach of the sound sample being background sound.

In the same field of endeavor, Ball teaches that it was well known in the art to add background sound to a voicemail message, (col. 7, lines 64-65; col. 8, lines 41-52; col. 26, lines 34-59).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Gold by adding the sound samples to the background as taught by Ball so that the user can listen to inspirational music along with the voice message dedication.

Regarding claim 2, Gold, as applied to claim 1, teaches wherein the providing occurs after the voice message is recorded, (paragraph 0036).

Regarding claim 3, Gold, as applied to claim 1, teaches wherein the providing occurs before the voice message is recorded, (fig. 1b; paragraph 0045).

Regarding claim 7, Gold, as applied to claim 1, teaches storing the combination message, (paragraph 0045).

Regarding claim 8, Gold, as applied to claim 1, teaches wherein the combining includes adding the selected sound sample to the recorded voice message, (paragraph 0045 and paragraph 0066).

Regarding claim 9, Gold, as applied to claim 1, teaches playing the combination message after the combining is completed, (paragraph 0007 and 0039).

Regarding claim 10, Gold, as applied to claim 1, does not specifically teach of looping the selected sound sample for a time duration equal to a time duration of the recorded voice message.

In the same field of endeavor, Ball teaches looping the selected sound sample for a time duration equal to a time duration of the recorded voice message, (col. 7, lines 64-65; col. 8, lines 41-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Gold by looping the selected sound sample as taught by Ball so that the music can be played during the entire voice message.

Regarding claim 11, Gold, as applied to claim 7, teaches depositing the stored combination message in a mailbox of a recipient, (paragraph 0045).

Regarding claim 12, Gold, as applied to claim 11, teaches wherein the recipient performs at least one of retrieving and listening to the combination message and forwarding the combination message, (paragraph 0066).

Regarding claim 13, Gold, as applied to claim 12, teaches separating the recorded voice message from the selected sound sample, (paragraph 0045).

Regarding claim 14, Gold, as applied to claim 13, teaches playing the separated recorded voice message without the selected sound sample, (paragraph 0045).

Regarding claim 15, Gold, as applied to claim 14, teaches forwarding the separated recorded voice message without the selected sound sample to a third party recipient, (paragraph 0066).

Regarding claim 16, Gold, as applied to claim 1, teaches receiving the sound samples from the user, (fig. 1a; paragraph 0036).

Regarding claim 17, Gold, as applied to claim 1, teaches listing the sound samples at a web site, (paragraphs 0045 and 0066).

Regarding claim 18, Gold, as applied to claim 17, teaches playing the sounds samples through the web site, (paragraphs 0045 and 0066).

Regarding claim 19, Gold, as applied to claim 18, teaches receiving at least one sound sample from the user via the web site, (fig. 1a; paragraph 0036).

Regarding claim 20, Gold, as applied to claim 1, teaches storing the recorded voice message with an identifier corresponding to the selected sound sample, (paragraphs 0045 and 0066).

Regarding claim 21, Gold, as applied to claim 20, teaches retrieving the stored voice message and the identifier, (paragraphs 0045 and 0066);

retrieving the sound sample corresponding to the identifier, (paragraphs 0045 and 0066);

combining the selected sound sample and the recorded voice message, (paragraphs 0045 and 0066); and

reproducing the combination for a recipient, (paragraphs 0045 and 0066).

Regarding claim 22, Gold, as applied to claim 1, teaches storing the selected sound sample together with the recorded voice message in a storage device, (paragraph 0066).

Regarding claim 23, Gold, as applied to claim 22, teaches wherein the selected sound sample and the recorded voice message are stored next to each other in the storage device, (paragraph 0066).

Regarding claim 24, Gold, as applied to claim 22, teaches wherein the selected sound sample and the recorded voice message are linked together in the storage device, (paragraph 0066).

Regarding claim 25, Gold, as applied to claim 22, teaches retrieving the stored sound sample and the recorded voice message, (paragraph 0066);

combining the stored sound sample and the recorded voice message, (paragraph 0066); and

reproducing the combination for a recipient, (paragraph 0066).

Regarding claim 30, Gold, as applied to claim 27, teaches wherein the processor stores the voice message in the storage device with an identifier corresponding to the selected sound sample, (paragraphs 0045 and 0066).

Regarding claim 31, Gold, as applied to claim 30, teaches wherein the processor prompts the user to select another one of the sound samples and replaces the identifier corresponding to the selected sound sample with an identifier corresponding to the another one of the sound samples, (paragraph 0045 and 066).

Regarding claim 32, Gold, as applied to claim 30, teaches wherein when a message recipient accesses the storage device to retrieve the recorded voice message, the processor retrieves the selected sound sample corresponding to the identifier from the storage device, combines the selected sound sample with the recorded voice message and reproduces the combination for a recipient, (paragraph 0066).

Regarding claim 33, Gold, as applied to claim 27, teaches wherein the storage device stores an audio stationary file corresponding to the user, (paragraph 0045). Gold does not specifically teach wherein the audio station file includes at least one of an audio header, footer and an audio body.

In the same field of endeavor, Ball teaches an audio stationary file including at least one of an audio header, an audio footer and an audio body, and the processor combines the recorded voice message with the audio body, adds the audio header to a beginning of the voice message and adds the audio footer to an end of the voice message, (table 1 - col. 8, lines 6-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the file of Gold to include an audio header, audio footer and an audio body as taught by Ball so that the processor will known how to sequence the voice message and music/song.

Regarding claim 34, Gold, as applied to claim 27, teaches a web interface, wherein the sound samples are listed at a web site connected to the apparatus via the web interface and the processor receives the selected sound sample together with an identifier corresponding to the user, via the web interface.

Regarding claim 35, Gold, as applied to claim 34, teaches wherein the processor receives additional sound samples from the user, (fig. 1a; paragraph 0036).

Regarding claim 36, Gold, as applied to claim 34, teaches wherein the processor extracts sound data corresponding to the selected sound sample and stores the sound data in the storage device together with the identifier corresponding to the user, (paragraph 0066).

Regarding claim 37, Gold, as applied to claim 27, teaches wherein the processor records at least one sound sample provided via a communication device by the user and stores the at least one sound sample in the storage device with an identifier corresponding to the user, (fig. 1a).

Regarding claim 38, Gold, as applied to claim 28, teaches wherein the processor provides access to the combination message stored in the storage device, (paragraph 0066).

Regarding claim 40, Gold, teaches a method of providing ambient sound to a recorded voice message, (abstract), comprising:

receiving a call from a caller, (paragraph 0045);

prompting the caller to select a sound sample, (paragraph 0045);

recording a voice message from the caller, (paragraphs 0045 and 0066);

adding the voice message to the selected sound sample to form a combination message; and storing the combination message in a storage device, (paragraph 0066).

Gold does not specifically teach wherein the sound sample is looped for a duration equaling a duration of the voice message.

In the same field of endeavor, Ball teaches looping the selected sound sample for a time duration equal to a time duration of the recorded voice message, (col. 7, lines 64-65; col. 8, lines 41-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Gold by looping the selected sound sample as taught by Ball so that so that the music can be played during the entire voice message.

Regarding claim 41, Gold teaches a method of adding sound to a greeting, (abstract; paragraph 0036), comprising:

providing a sound samples for selection by a recipient, (paragraphs 0045 and 0066);

receiving an indication of a selected sound sample, (paragraphs 0045 and 0066); and

combining the selected sound sample with a recorded greeting to form a combination greeting, (paragraphs 0045 and 0066).

In the same field of endeavor, Ball teaches that it was well known in the art to add background sound to a greeting, (col. 7, lines 64-65; col. 8, lines 41-52; col. 26, lines 34-59).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Gold by adding the sound samples to the background as taught by Ball so that the user can listen to inspirational music along with the voice message dedication.

10. Claims 4,5,6 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gold in view of Gerszber US Patent Pub. 2001/0050977.

Regarding claims 4 and 29, Gold, as applied to claims 3 and 27, teaches everything except playing the sound sample while the user records the voice message.

In the same field of endeavor, Gerszber teaches that it was well known in the art to play a sound sample to a user while the user records a voice message, (paragraph 0007).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the recording of Gold by playing the background music as the user is recording the voice message as taught by Gerszber so that the user can hear how the voice message will sound to the recipient.

Regarding claim 5, Gold, as applied to claim 4, teaches playing the combination message to the user, (paragraphs 0007 and 0039).

Regarding claim 6, Gold, as applied to claim 5, teaches prompting the user to select one of storing the combination message and repeating the providing until the user selects storing the combination message, (paragraph 0036).

Response to Arguments

11. Applicant's arguments filed March 3, 2005 have been fully considered but they are not persuasive.

Regarding claim 26, Applicants contend that Ball does not teach or suggest the combination of all three features as recited in claim 26. The Examiner respectfully disagrees.

As now recited in the rejection, Ball teaches a header preceding the message area and a footer following the message area. This can be clearly seen in at least table 1 which opens with "<PML> <AUDIO SRC-"inspirational.su" BACKGROUND/>" and ends with "<AUDIO SRC="when.au">,</PML>".

Regarding claims 27,28 and 39, Applicants contend that Gold et al. does not teach that the voice message and sound are combined and specifically Gold does not teach means for combining a selected sound sample with a recorded voice message to form a combination message. The Examiner respectfully disagrees.

Given the broad scope of the claims, by having a first message being followed by a second message wherein the first and second message are both played to a recipient then a combination message is created when the recipient hears both messages. In paragraph 0066, Gold specifically states the voice message and song dedication is played to the recipient. In paragraph 0070, Gold teaches that the voice dedication and the song can be combined into a single file.

Regarding claims 1 and 41, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gold has a desire to provide the voice message and song to a user. As shown in paragraph 0070, Gold makes several suggestions to combine the files together by in a plurality of different ways and formats. Thus the Examiner believes that adding the song as background music is within the scope of Gold and therefore believes that Gold can be combined with the teachings of Ball.

Furthermore, the Examiner notes that background music only appears in the preamble for claims 1 and 41 and thus, in response to applicant's arguments, the recitation "background music" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding claim 40, Applicant contends that there is nothing in Ball et al. that would suggest the looping features of the present claimed invention. The Examiner respectfully disagrees.

Ball specifically teaches the opening of the files starts with the background music, as shown in table 1. The generated message plays out in its entirety as the file moves down the list of files that are played consecutively. The background ends at the last step. Ball further reemphasized this in col. 8, lines 40-55 in which background music is played for the duration of the file. Since the background music plays for the entire message then it inherently loops for the duration of the message.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

571) 273-7537, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante

Ovidio Escalante
Examiner
Group 2645
June 27, 2005

O.E./oe